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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/751,565	01/05/2004	Masaaki Ueda	17339	3667
23389 7590 08/18/2008 SCULLY SCOTT MURPHY & PRESSER, PC 400 GARDEN CITY PLAZA SUITE 300 GARDEN CITY, NY 11530				
EXAMINER				
JOHNSON III, HENRY M				
ART UNIT		PAPER NUMBER		
3739				
MAIL DATE		DELIVERY MODE		
08/18/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/751,565

Applicant(s)

UEDA ET AL.

Examiner

Henry M. Johnson, III

Art Unit

3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 June 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 7, 9, 13, 15, 20, 22 and 26 is/are allowed.
- 6) ☒ Claim(s) 1-6, 8, 10-12, 14, 16-19, 21, 23-25 and 27-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Final Drawing Review (PTO-849)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Response to Arguments

Applicant's arguments have been fully considered and are persuasive with respect to rejections under 35 U.S.C. § 112 and the rejections have been withdrawn.

Applicants arguments regarding rejections under 35 U.S.C. § 103 have been fully considered and are not persuasive. Shimmura et al., like the Applicant, disclose an instrument holder with multiple degrees of movement to provide the flexibility required in the surgical arena including various joints and a ball joint. The extension arm of Shimmura et al. has an axis 0h indicating rotation that would allow the ball joint to be below the instrument. Applicant's arguments are based on rearrangement and/or reversal of well known components. The reversal of components in a prior art reference, where there is no disclosed significance to such reversal, is a design consideration within the skill of the art. In re Gazda, 219 F.2d 449, 104 USPQ 400 (CCPA 1955); In re Japikse, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950). It has been held that a mere reversal of the essential working parts of a device involves only routine skill in the art. In re Einstein, 8 USPQ 167. The examiner takes the position that since various surgical procedures require differing instrument positioning to provide access, a skilled artisan would be motivated to modify the holder to provide such access or to combine the basic holder with an adjustable holder based on existing art and common sense.

"The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.

"If a person of ordinary skill can implement a predictable variation, §103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill. Sakraida and Anderson's-Black Rock are illustrative. A court must ask whether the improvement

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is more than the predictable use of prior art elements according to their established functions."

See KSR [127 S Ct. at 1739].

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-6, 8, 10-12, 14, 16-19, 21, 23-25, and 27-35 are rejected under 35

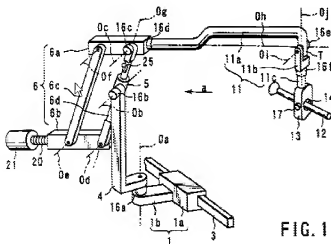


FIG. 1

U.S.C. 103(a) as being unpatentable
over U.S. Patent Application
Publication US 2001/0027313 to
Shimmura et al. in view of U.S.
Patent 5,957,423 to Kronner.
Shimmura et al. teach a medical

instrument holding apparatus with a portion for holding an instrument (Fig. 1, # 14), a support arm (Fig. 1, # 11a), a base support (basal portion, Fig. 1, #s 3 & 4), a shaft coupled to the basal support (Fig. 1, # 4), the shaft forming part of a parallelogram moving (moving mechanism) structure (Fig. 1, # 6) with a counterweight (Fig. 1, # 21) to offset the weight of the support arm (Fig. 1, # 11a) and instrument. Multiple axes of rotation within the supporting mechanism are disclosed (Fig. 1, #s 0a – 0j). Arm 6a is clearly shorter than arm 6c of the parallelogram. A ball joint is disclosed that connects the moving portion to an instrument support portion (Fig. 7, #16h). The support shaft (Fig. 1, # 11a) has an axis-of-rotation (0h), inherently allowing the ball joint to be above, below or on a horizontal plane with the instrument holding means. As the angle of inclination within the ball joint changes, so will the position of the center of gravity, said center of gravity also being dependent on the size and weight distribution of the instrument. Since the center of gravity of the instrument and support depends on the instrument and the orientation, the ball joint is clearly capable of being oriented in any relation to the center of gravity. An operator may grasp any portion of the support and instrument elements. Electromagnetic locks as means for braking their respective movable sections are disclosed (Fig. 1, #s 16a-16f), with an activating switch on the holding portion (paragraph 0059). A braking means is also disclosed for the ball joint (paragraph 0092). The instrument holding portion is interpreted is capable of being held by an operator and is coupled to the support arm by rotatable joints (Fig. 1, #s 16e & 16f). The upper portion of the parallelogram is shorter than the lower portion with the counterweight and either of the side arms. The counterweight is adjustable via screw threads (Fig. 1, # 20). The apparatus of Shimmura et al. implicitly has centers of gravity, centers of inclination and forces exerted within the device based on the weights of the instrument and counterweights. Relative positions of apparatus components will vary as the instrument is positioned and can assume limitless configurations. The apparatus is

therefore interpreted as capable of the position(s) cited. Shimmura et al. do not specifically teach an instrument holder capable of achieving an instrument axis parallel to the rotation axis of a ball joint. Kronner discloses an adjustable instrument holder that allows an instrument to assume a variety of positions as might be required during a surgical process. The positioning of the instrument is based on the intended use and a skilled artisan would clearly be motivated to combine the adjustable holder of Kronner with the device of Shimmura et al. to achieve the desired positioning of the instrument.

Regarding claim 2, the position of the brake switch is considered a design choice within the skill of the art. Both foot switches and hand switches are common in the art.

Regarding claims 33 and 34, a skilled artisan knows that endoscopes typically include multiple lumens for instruments and observation during an endoscopic procedure. It would have been obvious to one skilled in the art to include optics and imaging in the instrument as it is common and well known to do so.

Allowable Subject Matter

Claims 7, 9, 13, 15, 20, 22 and 26 are allowed.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Henry M. Johnson, III whose telephone number is (571) 272-4768. The examiner can normally be reached on Monday through Friday from 5:30 AM to 2:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Henry M. Johnson, III/
Primary Examiner, Art Unit 3739

/HMJ/
8/15/2008